THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte THOMAS FERRY and JANN WILSON

Appeal No. 95-1292
Application 07/911,471

ON BRIEF[1]

Before KRASS, JERRY SMITH, and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

FINDINGS OF FACT

We have reviewed the record in its entirety in light of the arguments of Applicants and the examiner. Our decision presumes familiarity with the entire record. A preponderance of the evidence of record supports each of the following fact findings.

A. The nature of the case

A This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 2, 4-9, and 11-21, which are all of

[1] Applicants waived the hearing. (Paper 20.)

the pending claims. Claims 3 and 10 have been canceled. (Paper 11 at 1.)

B The application on appeal was filed on 10 July 1992. It purports to be a continuation-in-part of U.S. patent application 07/728,341, filed 11 July 1991, which is expressly incorporated by reference into the present application. (Paper 1 at 1.)

C The title of the invention is "Apparatus for facilitating the display of information relating to the origin of a third source caller". (Paper 10 at 1.)

D Applicants address the problem of displaying Caller ID information relating to a third-party caller during an on-going telephone conversation between a first party and a second party. Their invention displays third-party caller information from a Caller ID service on a conventional television set or similar video device. (Paper 1 at 4-5.) They acknowledge that products for displaying Caller ID information on a computer monitor already exist, but they indicate that such products do not appeal to non-business consumers. (Paper 1 at 1-3.)

B. The rejections

E The examiner relied on the following prior art references in rejecting the claims (Paper 11 at 2-7):[2]

Griffith	4,805,210	14 Feb. 1989
Ueno	5,061,992	29 Oct. 1991 (filed 23 Jan. 1990)
Krisbergh et al.	5,138,649	11 Aug. 1992 (filed 16 Nov. 1990)
Takabayashi	(JP) 3-29456[3]	published 7 Feb. 1991

F The examiner rejected all of the claims on appeal under 35 U.S.C. § 103. He rejected claims 1, 2, 4, 6-9, 11,

---

[2] The examiner also cited, but did not apply, the following references (Paper 16 at 3):

Doughty	4,582,956	15 Apr. 1986
Dittakavi et al.	4,852,151	25 July 1989
Goldman et al.	4,995,074	19 Feb. 1991
Callele et al.	5,117,452	26 May 1992

We do not consider these additional references to be part of the examiner's rejection of the claims. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). We may, however, consider such references to the extent that they explain rather than expand the references on which the rejection is based. In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1284 (Fed. Cir. 1991). Applicants waived their opportunity to respond to these additional references when they waived their hearing. (Paper 20.)

[3] Our understanding of this reference is based on a translation in the record provided by the Patent and Trademark Office.

and 13-21 in view of Takabayashi and Ueno (Paper 11 at 2); claims 5 and 12 in view of Takabayashi, Ueno, and Griffith (Paper 11 at 4); claims 1, 2, 4, 6-9, 11, 13-16, 18, and 20 in view of Krisbergh and Ueno (Paper 11 at 5); claims 17, 19, and 21 in view of Krisbergh, Ueno, and Takabayashi (Paper 11 at 7); claims 5 and 12 in view of Krisbergh, Ueno, and Griffith (Paper 11 at 7).

Fact findings 7 through 11 would have been known to a person having ordinary skill in the art at the time of the invention.

G The Takabayashi reference teaches a caller ID system in which the name of the caller is displayed on a conventional television screen. (Abstract; p. 1.) Takabayashi notes that displaying the caller's name is an improvement over the prior art, which only displayed the caller's telephone number. (p. 1-2.) He does not disclose the display of a third-party's information when the telephone is already in use.

H The Ueno reference is directed to displaying a third-party caller ("C") using a "TV phone" to one of two callers ("A" and "B") already in conversation using a TV phone system. According to Ueno, the prior art only permitted a kind of Call Waiting function, where if C called B, B would have to put A on hold to learn the identity of C. As Ueno notes, if

the conversation with A has greater priority than a conversation with C, then placing A on hold to identify C is at least inconvenient. (1:10-40.) Ueno solves this problem by displaying C on a split screen to B without interrupting the A-B conversation. (1:43-63.) B is never placed on hold because Ueno uses two separate interface circuits **202** & **203** to handle the two callers. Since Ueno shows C's image, he does not address displaying C's name or number. Ueno does not disclose the effect of having more than one TV phone in operation at B's location when C's call arrives.

I The Krisbergh reference, among other things, displays incoming and outgoing telephone numbers on a television display. (2:66-3:10 and 5:35-54.) Krisbergh does not display names. The reference does not address the display of telephone numbers for third-party callers. Krisbergh does not disclose the effect of having more than one telephone off the hook when a third-party calls.

J The Griffith reference teaches a lock-out circuit for locking out all other telephones on a circuit when one telephone on the circuit is in use. (2:17-56.)

K We take official notice of the fact that the Federal Communications Commission had adopted the National Television System Committee signal standard as the standard

for color television signals in the United States. See e.g., Re-Examination of Technical Regulations, 48 Fed. Reg. 14399 n.7 (1983) ("The National Television Systems Committee (NTSC) of the Electronics Industries Association (EIA) prepared the standard specifications approved by the FCC, December, 1953, for commercial color television broadcasting."); see also "National Television System Committee", McGraw-Hill Electronics Dictionary 356 (5th ed. 1994) (attached). On this basis, we find that a person having ordinary skill in the art would have found it necessary at the time of the invention to use an NTSC signal for a television-based invention to have wide commercial appeal in the United States (or Canada, Mexico, or Japan). If anything, it would have been unusual not to have used the standard.

L The level of skill in the art and secondary considerations supporting patentability are not contested issues in the present appeal.

CONCLUSIONS OF LAW

A. Claim interpretation

A All of the claims on appeal are written in either means-plus-function (claims 1, 2, 4-7, and 15-19) or step-plus-function (claims 8, 9, 11-14, 20, and 21) format.

B We must give claims their broadest reasonable interpretation. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Although means-plus-function and step-plus-function claims are inherently narrow because they are limited to structures and acts found in the specification or their equivalents, 35 U.S.C. § 112, we remain obliged to give them the broadest construction possible within the law. In particular, we may not read into a claim limitations that are expressly added in a dependent claim. Transmatic Inc. v. Gulton Indus., 53 F.3d 1270, 1277, 35 USPQ2d 1035, 1041 (Fed. Cir. 1995) (applying the doctrine of claim differentiation in the context of dependent claims).

B. Claim grouping

C Although Applicants state that the claims on appeal do not stand or fall together (Paper 14 at 7-8), we are guided by what Applicants actually argue. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). We note that Applicants argue related apparatus and method claims together, so we will treat them as standing or falling together.

C. Obviousness

D Obviousness cannot be rebutted by attacking references individually where the rejection is based upon the teachings of a combination of references. A reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). On the other hand, the examiner may not use the claimed invention as a template to piece together the teachings of the prior art to render the claimed invention obvious. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

E Takabayashi and Ueno, viewed as a whole, would have rendered the subject matter of claims 1, 2, 8, 9, and 15-21 obvious at the time of the invention. Both references display caller information on a television screen. In the case of Takabayashi, the caller information is the caller's name; for Ueno, the information is the caller's image. To display the caller information, both references must detect an incoming telecommunication, and must decode and transfer that information to the television display. Ueno provides the means for establishing a communication path between two callers with the capacity to detect a third caller and pass

the third caller's connection request onto one of the original callers. Takabayashi teaches that caller information may be either a telephone number or a name, both of which are alphanumeric.

F The claims do not expressly limit the nature of the telephone communication path or the nature of the television. Although Applicants argue that Takabayashi uses an integrated services digital network (ISDN) line (incidently Ueno also uses an ISDN line) and that Ueno uses a "special" television, we note that these are either within the scope of the claims or, at least, structurally equivalent. Moreover, Applicants provide no evidence that Ueno's television is any different from a conventional television.

G Applicants note that Takabayashi does not teach all of the limitations of claims 1 and 8. (Paper 14 at 11.) We note, however, that Takabayashi is applied in combination with Ueno, which provides the stated missing elements. Applicants also urge that Ueno does not teach detection and decoding of the third caller's video image. We disagree. Detection of incoming calls is inherent in any telephone system. Detection of third-party callers is called Call

Waiting. Ueno expressly teaches an image decoding circuit **210** for the video signal. (Fig. 2; 3:51-56.)

H Applicants argue that Takabayashi and Ueno are directed to different problems and contain no suggestion to combine their teachings. The teaching value of a reference, however, is not limited to its stated purpose. In re Heck, 699 F.2d 1331, 1333, 216 USPQ 1038, 1039 (Fed. Cir. 1983). Moreover, the "references need not explicitly suggest combining teachings". In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). Ueno shows a Caller ID/Call Waiting arrangement in a very complex telecommunications system. The problem Ueno solves is not unique to TV phones. Takabayashi shows a simple and inexpensive Caller ID system using existing televisions. One seeking to implement a low-cost version of Ueno's invention would be naturally motivated to apply Takabayashi's technology to the problem.

I Ueno provides the additional elements of claims 2 and 9. Ueno teaches a communication path between two callers that recognizes a request from a third caller.

J Claim 15 provides for the transmission of third-caller information to the television as a television signal while the communication path between the first two callers is

preserved. Claim 16 requires the signal to be an NTSC signal. Both Takabayashi and Ueno transmit caller information to a television. Ueno further teaches transmitting third-party caller information to the television while the first communication path is preserved. As we noted earlier, anyone implementing the Takabayashi/Ueno system on a standard television in the United States (or Japan for that matter) would have used an NTSC signal because the NTSC set the standard for television signals.

K Claims 17-21 require displaying the caller information in an alphanumeric format, including at least either a telephone number or a name. Takabayashi teaches displaying the name as an improvement over the existing practice of displaying the number. One skilled in the art would have been motivated to choose at least one or the other for display on a conventional television set. Although a name is easier to comprehend, the number is more convenient for returning the call later. One skilled in the art would likely provide both since the same character generator can easily produce both. In any case, the choice between these two known options (each with advantages and not mutually exclusive) does not present a patentable distinction.

L Since we sustain the rejection of claims 17-21 under section 103 in view of Takabayashi and Ueno, it follows that we would also sustain the rejection of claims 17, 19, and 21 under section 103 in view of Takabayashi, Ueno, and Krisbergh. Krisbergh does not detract from the teachings and suggestions of Takabayashi and Ueno. Instead, Krisbergh offers a second example of a television being used as a Caller ID display device.

M Claims 4 and 11, and their dependent claims 6, 7, 13, and 14, present a different problem. These claims require structures or acts to implement a temporary hold function. We agree with the examiner that the hold function is well known in telephony. Ueno, however, uses a different approach to implement Call Waiting/Caller ID. He uses two parallel interfaces: one for the original call and one for the third-party call. Takabayashi does not cure the deficiency. Certainly a hold function would be expedient in this context, but the cited references do not suggest this expedient. Absent a motivation, expressed or implied, from the references, we cannot modify the references as the examiner proposes without using hindsight. Thus, we cannot sustain this rejection of these claims.

N Claims 5 and 12, which depend from claims 4 and 11, respectively, stand rejected in view of Takabayashi, Ueno, and Griffith. Griffith does not cure the lack of a hold function. Thus, we cannot sustain this rejection of these claims either.

O The rejection of claims 1, 2, 4, 6-9, 11, 13-16, 18, and 20 in view of Krisbergh and Ueno essentially parallels the previous rejection in view of Takabayashi and Ueno. Although Krisbergh is principally concerned with other things, it does unambiguously teach the use of a television to identify the telephone number of incoming calls. In this respect, it parallels the teaching of Takabayashi. Thus, an artisan seeking to implement a low-cost version of Ueno's Caller ID/Call Waiting system would have been inspired to use existing television equipment as an inexpensive way to implement the Caller ID aspect of the system.

P Once again, Ueno teaches the basic concept of a Caller ID/Call Waiting system. Krisbergh is only used to show a relatively low-cost implementation of a Caller ID system using an existing television. The fact that neither reference anticipates the claimed invention does not detract from the relevance of their teachings in combination. As

previously noted, Ueno expressly teaches decoding a caller information signal for the third caller.

Q As with the Takabayashi/Ueno low-cost Caller ID/Call Waiting system, the Krisbergh/Ueno system would forward the Caller ID information to Krisbergh's television while the third caller is in Call Waiting mode. This meets the requirement of claim 15. As previously noted, an artisan would naturally use an NTSC signal in a system using a conventional television. Thus, claim 16 presents no patentable distinction.

R Since Krisbergh explicitly teaches displaying the caller's telephone number, it satisfies, in combination with Ueno, the requirement in claims 18 and 20 that the caller information comprise a telephone number.

S Krisbergh does not teach a specific hold function. Although the hold function is known in telephony, the cited references do not provide a motive for implementing the hold function. Thus, we cannot sustain this rejection under section 103 of claims 4, 6, 7, 11, 13, and 14. Since Griffith does not resolve this deficiency, we must also reverse the rejection under section 103 of claims 5 and 12 in view of Krisbergh, Ueno, and Griffith.

DECISION

We affirm the rejection of claims 1, 2, 8, 9, and 15-21 as obvious in view of Takabayashi and Ueno. We reverse this rejection as applied to claims 4, 6, 7, 11, 13, and 14. We also reverse the rejection of claims 5 and 12 as obvious in view of Takabayashi, Ueno, and Griffith.

We also affirm the rejection under section 103 of claims 1, 2, 8, 9, 15, 16, 18, and 20 in view of Krisbergh and Ueno and of claims 17, 19, and 21 in view of Takabayashi, Ueno, and Krisbergh. We reverse the rejection under section 103 of claims 4, 6, 7, 11, 13, and 14 in view of Krisbergh and Ueno. We also reverse the rejection of claims 5 and 12 as obvious in view of Krisbergh, Ueno, and Griffith.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(b).

AFFIRMED-IN-PART

ERROL A. KRASS Administrative Patent Judge	)
JERRY SMITH Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)

Appeal No. 95-1292
Application 07/911,471

GREENBLUM & BERNSTEIN, P.L.C.
1941 Roland Clarke Place
Reston, Virginia 22091

27 November 1998

To: Alicie Callaham
Legal Tech

From: Richard Torczon
Administrative Patent Judge

Re: Appeal No. 95-1292

Attached is the record and a draft decision for the captioned appeal. I have also e-mailed an electronic copy to you. Please:

1. Proofread the draft decision;

2. Verify

   * quotes and

   * citations (including point citations);

3. Shepardize® the cited cases;

4. Prepare the decision for circulation;

5. Return the record with the prepared decision to me; and

6. Send me an electronic copy of the prepared decision via e-mail.

Thank you.

Attachment